The opinion in support of the decision being entered today was not written
for publication and is not binding precedent of the Board.

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES

Ex parte WAYNE F. GORSEK

Appeal No. 2005-0406
Application No. 10/187,616

ON BRIEF

Before SCHEINER, ADAMS, and GRIMES, Administrative Patent Judges.

ADAMS, Administrative Patent Judge.

DECISION ON APPEAL

This is a decision on the appeal under 35 U.S.C. § 134 from the examiner's final rejection of claims 1 and 2, which are all the claims pending in the application.

Claim 1 is illustrative of the subject matter on appeal and is reproduced below:

1. A healthy bone maintenance composition comprising an effective amount of:

   Calcium;
   Magnesium;
   Vitamin D;
   Vitamin K-1;
   Folic Acid; and
   Soy Isoflavones.

The references relied upon by the examiner are:

Walsh	6,139,872	Oct. 31, 2000
Forusz et al. (Forusz)	6,436,446	Aug. 20, 2002
(102(e) date Jul. 30, 1999)		

Balch et al. (Balch), PAGET'S DISEASE OF BONE IN A PRESCRIPTION FOR NUTRITIONAL HEALING: A PRACTICAL A-Z REFERENCE TO DRUG FREE REMEDIES USING VITAMINS, MINERALS, HERBS & FOOD SUPPLEMENTS, pp. 417 (2ND ed., Avery Publishing, New York 1997)

GROUND OF REJECTION

Claims 1 and 2 stand rejected under 35 U.S.C. § 103. As evidence of obviousness the examiner relies on Forusz, Balch and Walsh.

We reverse.

DISCUSSION

As best we can understand the examiner's rejection, Forusz is relied upon to teach (column 2, lines 37-40), "a composition that includes a supplement to provide the dietary needs of individuals for nutrients to support adequate bone density and a healthy skeletal system." The composition of Forusz comprises

Calcium	500-2000 mg
Magnesium	100-700 mg
Isoflavones (soy)	50-200 mg
…	
Vitamin D3[1]	400-800 IU
Vitamin K[2]	35-85 µg
….	

Forusz, however, does not teach folic acid as a component of the composition. See Answer, page 5. To make up for this deficiency, the examiner relies on

[1] According to the examiner (Answer, page 4), appellant defines vitamin D as "cholecalciferol (p.2, [i]nstant specification)." The examiner finds (id.), Forusz discloses that the vitamin D used therein is "[v]itamin D_3 (cholecalciferol)." See Forusz, column 3, lines 15-20.

Balch. According to the examiner (id.), Balch "disclosed that folic acid was an essential nutrient in treating Paget's disease, a disease characterized by excessive bone loss." We note the table of "essential" nutrients taught by Balch. Balch, page 417. Most of the nutrients listed on this table are related to bone growth or formation. Folic acid, however, is not one of those nutrients identified by Balch to be related to bone growth or formation. To the contrary, as we understand Balch's table, folic acid is an essential nutrient for "energy production." See Balch, table, page 417.

Thus, we cannot agree with the examiner's conclusion (Answer, page 6), "according to Balch et al., the skilled artisan would have reasonably concluded that the addition of folic acid into the diet aided in the indirect formation of bone." See also Answer, bridging sentence pages 6-7. Balch teaches nothing about a relationship between folic acid and bone formation. To the contrary, Balch simply implies that a person suffering Paget's disease of bone would benefit by supplementing their diet with folic acid for energy production. Balch also does not teach a single composition as is required by the claimed invention, but instead appears to suggest the use of individual nutrient supplements.

We recognize the examiner's argument (Answer, page 7), "the skilled artisan would have recognized the advantage of combining ingredients to aid in the same underlying purpose; to increase bone density."[3] However, as we

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[2] The examiner finds (Answer, bridging sentence, pages 4-5), "[t]he [v]itamin K proposed by Forusz et al. was phylloquinone (col.3, line 27)." According to the examiner (Answer, page 5), Walsh teach "[v]itamin K-1 was known in the art as phylloquinone…."

[3] See e.g., In re Kerkhoven, 626 F.2d 846, 850, 205 USPQ 1069, 1072 (CCPA 1980) ("it is prima facie obvous to combine two compositions each of which is taught by the prior art to be useful for the same purpose, in order to form a third composition which is to be used for the very same purpose."); Accord In re Susi, 440 F.2d 442, 445, 169, USPQ 423, 426 (CCPA 1971) ("the

understand it, the problem with the examiner's logic is that there is no teaching on this record that the composition of Forusz and folic acid are useful for the same purpose. To the contrary, the evidence of record demonstrates that the composition of Forusz provides nutrients to support adequate bone density and a healthy skeletal system, while folic acid is for energy production. While Balch includes folic acid in a list of nutrient supplements implied to be used by a person suffering from Paget's disease of bone, there is no suggestion in Balch, or any other reference of record, that folic acid is useful for anything other than energy production. Therefore, contrary to the examiner's assertion, it is our opinion that a skilled artisan would not have recognized that folic acid as taught by Balch, would be useful in the composition disclosed by Forusz.

As set forth in Ecolochem Inc. v. Southern California Edison, 227, F.3d 1361, 1375, 56 USPQ2d 1065, 1075 (CAFC 2000) the:

> "[S]uggestion to combine may be found in explicit or implicit teachings within the references themselves, from the ordinary knowledge of those skilled in the art, or from the nature of the problem to be solved." … However, there still must be evidence that "a skilled artisan, confronted with the same problems as the inventor and with no knowledge of the claimed invention, would select the elements from the cited prior art references for combination in the manner claimed." … "[A] rejection cannot be predicated on the mere identification … of individual components of claimed limitations. Rather particular findings must be made as to the reason the skilled artisan, with no knowledge of the claimed invention, would have selected these components for combination in the manner claimed."…. [Citations omitted].

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combination, for the same purpose, of one additive explicitly disclosed in the prior art and another suggested by the prior art would at least prima facie obvious"); In re Crockett, 279 F.2d 274, 276-77, 126 USPQ 186, 188 (CCPA 1960) ("the idea of combining them [magnesium oxide and calcium carbide] would flow logically from the teaching of the prior art and therefore that a claim to their joint use is not patentable").

On the record before us, we find no reasonable suggestion for combining the teachings of the references relied upon by the examiner in a manner that would have reasonably led one of ordinary skill in this art to arrive at the claimed invention. Accordingly, we reverse the rejection of claims 1 and 2 under 35 U.S.C. § 103.

REVERSED

Toni R. Scheiner Administrative Patent Judge	) BOARD OF PATENT
Donald E. Adams Administrative Patent Judge	) APPEALS AND
Eric Grimes Administrative Patent Judge	) INTERFERENCES

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